

Appl. No. : 10/009,575  
Filed : August 6, 2002

## REMARKS

In response to the final Office Action mailed June 30, 2005, Applicant respectfully requests reconsideration of the application in view of the remarks set forth below.

### Discussion of Support for Previous Claim Amendment

The Examiner has stated that the previously amended claim term "providing the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing" is not supported by the specification. *See the Office Action at page 13.* Applicant respectfully disagrees. Applicant respectfully submits that the claim term is supported by the specification at page 4, line 29 through page 5, line 8, and Figure 2.

### Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 19-36 under 35 U.S.C. § 103 (a) as being unpatentable over Olivier (U.S. Patent No. 6,480,885) and Ogilvie (U.S. Patent No. 6,324,569). Applicant respectfully traverses the Examiner's claim rejections as discussed below.

#### Standard of *Prima facie* Obviousness

In order to provide a *prima facie* showing of obviousness under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art. *See, e.g., In re Royka*, 490 F. 2d 981, 180 U.S.P.Q. 580 (CCPA 1974); MPEP 2143.03.

#### Patentability of Pending Claims 19-36

Each of amended Claims 19, 29-30 and 36 recites, among other things, providing the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing. Applicant respectfully submits that neither Olivier nor Ogilvie, having prior art status in pertinent part, teaches or suggests the above-recited features.

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**1. The Portions of Ogilvie Cited by the Examiner Are Not in Fact Prior Art**

The Examiner asserted, citing four passages of Ogilvie (column 1, lines 45-65; column 2, lines 1-7; column 7, lines 4-22; and column 8, lines 2-11), that it is old and well known to “provide the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing.” However, Applicant respectfully submits that the above passages were not disclosed in the parent applications of Ogilvie which antedate this application’s priority date of May 12, 1999 as discussed below.

**A. With Regard to Column 1, lines 45-65**

The passage states that “Some email systems provide filters that detect at least some incoming unsolicited email and either deletes it or, more typically, places it in a directory or folder reserved for such messages. But filters sometimes err, either by characterizing as unsolicited email a message that is not, or by failing to detect unsolicited email and letting it through with the normal correspondence from familiar senders...removed from the list.” However, the above cited passage is not included in the provisional application (Application No. 60/101,517) filed September 23, 1998. Furthermore, this passage is not included in the provisional application (Application No. 60/104,138) filed October 14, 1998. The passage was first introduced in the application (Application No. 09/399,066) filed September 18, 1999 which is AFTER the priority date of this application (May 12, 1999).

**B. With Regard to Column 2, lines 1-7**

The passage states “the fact that a recipient has voluntarily subscribed...subscription service.” However, none of the parent applications of Ogilvie (Applications Nos. 60/101,517, 60/104,138 and 09/399,066) teach the above-indicated passage. This passage was first disclosed in the Ogilvie patent filed July 18, 2000 which is AFTER the priority date of this application (May 12, 1999).

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**C. With Regard to Column 7, lines 4-22**

The passage states “ Note that conventional options for handling attachments may be combined with the removal indicators 210. For instance, conventional email clients such as the Eudora Pro 3.0 program permit one to specify...deleted.” However, none of the priority applications of Ogilvie (Applications Nos. 60/101,517, 60/104,138 and 09/399,066) teach the above-indicated passage. This passage first appears in the Ogilvie patent filed July 18, 2000 which is AFTER the priority date of this application (May 12, 1999).

**D. With Regard to Column 8, lines 2-11**

The passage states “In conventional email systems, by contrast, recipients are burdened with removing essentially all unwanted messages... attend to its disposal.” However, neither of the priority applications of Ogilvie (Applications Nos. 60/101,517 and 60/104,138) teaches the above-indicated passage. This passage first appears in the parent application (Application No. 09/399,066) of Ogilvie filed July 18, 2000, which is AFTER the priority date of this application (May 12, 1999).

**E. Summary**

As discussed above, the passages that the Examiner has cited are not prior art under 35 U.S.C. §§ 102 and 103 with respect to the claimed invention. Thus, Applicant respectfully submits that it is not old and not well known to “provide the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing” in view of Ogilvie.

**2. Ogilvie Neither Teaches Nor Suggests “providing the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing”**

Ogilvie is directed to automatic deletion of an undesirable message in order to reduce a recipient's burden to manually delete spam mails. *See column 2, lines 32-45.* Ogilvie further states that:

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During a creating step 204 the originator 200 creates a self-removing message 206 using software and hardware configured by the software, or using custom hardware alone, according to the teachings herein. This may be done generally in accordance with familiar tools and techniques for email messaging, attaching files, embedding graphics, encrypting data, and/or compressing data, but it must associate code and/or hardware 208, and/or indicators 210, with the message 206 to perform or facilitate the self-removal message management functions described here. That is, the originator 200 (or equivalently, an embodiment under the originator's direction) marks the message 206 at the origin, includes removal code 208 in the message 206, or does both.

*See column 5, lines 6-18 of Ogilvie*

In order to automatically delete an unapproved message (its intended function), Ogilvie is required to use a self-removal indicator (or code). Thus, the Ogilvie patent cannot, and does not, teach or suggest “providing the recipient with an option to view the unapproved message and selectively delete the message, *without using a self-removing message indicator*, after viewing” recited in independent Claims 19, 29-30 and 36.

The Examiner asserted, citing column 9, lines 59-66, that Ogilvie teaches “provide the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing” by allowing a recipient to overwrite the self-removing message after the unapproved being read, so the recipient has an option to manually delete the unapproved message by moving it from the inbox to the trash folder. *See the Office Action at page 13.* Applicant respectfully disagrees. Furthermore, Applicant reserves the right to challenge whether the cited portion is disclosed in the provisional applications (Application No. 60/101,517 filed September 23, 1998 and Application No. 60/104,138 filed October 14, 1998), which antedate the priority date (May 12, 1999) of the claimed invention.

The cited portion describes a message removing step (234) where a message (206), including a self-removal indicator (210), is removed at the client's browser. This removing step (234) is performed based on the message (206) including a self-removal indicator (210). *See also Figure 2.* That is, the message (206) is required to include the self-removal indicator (210) to perform the removing step (234). Therefore, this cited passage does not teach “provide the

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recipient with an option to view the unapproved message and selectively delete the message, *without using a self-removing message indicator, after viewing*” since the claimed invention does not use a self-removing message indicator so as to delete an unapproved message.

**3. Olivier Neither Teaches Nor Suggests “providing the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing”**

Olivier is concerned with managing a subscription mailing list and improvements to that process. *See column 3, lines 35-60.* Olivier further states that:

If the message isn't approved or rejected after 5 days or another period of time, it is removed from the database and returned to the sender. If a moderator approves the message, it is then sent to the distribution list. If it is rejected, the sender is informed via email. In either case the message is then removed from the suspended messages table.

*See column 15, lines 9-15 of Olivier*

In Olivier, if a message is unapproved or rejected, the sender, not the recipient, is notified. The recipient is not notified about the unapproval of the message. Furthermore, such a rejected message is not sent to the recipient. The Examiner has acknowledged as such in this Office Action. *See the Office Action at page 3.*

Thus, Applicant respectfully submits that Olivier cannot, and does not, teach or suggest “providing the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing” recited in independent Claims 19, 29-30 and 36.

The Examiner asserts, citing column 16, lines 25-62, that “Such teaching of Olivier has the functional limitation of sending a notification to the recipient when a message is unapproved with respect to the message criteria data set by the sender. Once the notification is set by Olivier in the message criteria data, the recipient will automatically receives an acknowledgement as to whether a message is approved or not.” *See the Office Action at page 3.*

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Applicant respectfully disagrees. Applicant respectfully submits that Olivier does not describe any functionality that notifies the recipient in the cited portion. Unapproved in the context of Olivier is simply a message that does not match the subscriber's profile. Indeed the recipient-subscriber does not receive anything. The intent and function of Olivier is to only receive messages that match the subscribers criteria. Ipso facto, messages that do not match the criteria are not received by the subscriber/recipient because these are not wanted by the subscriber/recipient. Applicant respectfully submits that in a mailing list environment as in Olivier, there would be no point in notifying the recipient of messages that do not match their criteria.

#### **4. There is No Motivation or Suggestion to Modify Prior Art References to Arrive at the Claimed Invention**

Applicant respectfully submits that there is no motivation or suggestion to modify the Ogilvie system to arrive at the claimed invention. As discussed above, in order to perform its intended function, the Ogilvie system must include a self-removal indicator or code in an email message to be transmitted. If the Ogilvie system were modified to delete a self-removal indicator or code from the email message, such modification would render the Ogilvie device inoperable for its intended purpose because an unapproved message would not be automatically deleted at a recipient's computer. *MPEP 2143.01*.

Furthermore, Applicant respectfully submits that there is no motivation or suggestion to modify the Olivier system to arrive at the claimed invention. As discussed above, in a mailing list environment such as in Olivier, there is no point or need to "notify recipients of emails that are unapproved and store such emails" let alone "provide the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing." Thus, a skilled person would not have been motivated to modify the Olivier system as in the claimed invention.

In view of the above, Applicant respectfully submits that there is no motivation or suggestion to modify the Ogilvie and Olivier systems to arrive at the claimed invention.

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### **5. Summary**

As discussed above, neither Olivier nor Ogilvie teaches or suggests “providing the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing” recited in independent Claims 19, 29-30 and 36. Furthermore, there is no motivation or suggestion to modify the prior art references to arrive at the claimed invention. In view of the above, independent Claims 19, 29-30 and 36 are allowable over the prior art of record. Claims 20-28 and 31-35 depend from base Claim 19 or 30, and further define additional technical features of the present invention. In view of the patentability of their base claims, and in further view of their additional technical features, Applicant respectfully submits that the dependent claims are patentable over the prior art of record.

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CONCLUSION

In view of Applicant's foregoing remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 10/18/05

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